



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/918,509	08/01/2001	Kazuhiko Hayashi	Q65676	3298

7590

03/17/2006

SUGHRUE, MION, ZINN, MACPEAK & SEAS
2100 Pennsylvania Avenue, N.W.
Washington, DC 20037

EXAMINER

SWEARINGEN, JEFFREY R

ART UNIT	PAPER NUMBER
----------	--------------

2145

DATE MAILED: 03/17/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/918,509

Applicant(s)

HAYASHI, KAZUHIKO

Examiner

Jeffrey R. Swearingen

Art Unit

2145

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 March 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4, 6-20 and 22-32 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4, 6-20 and 22-32 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION***Response to Arguments***

1. Claims 11 and 12 are rejected under 35 U.S.C. 101 as being directed to non-statutory subject matter. Applicant's amendments do not overcome the Interim Guidelines for Examination of Patent Application for Patent Subject Eligibility, Annex IV, which is the current Office policy on statutory subject matter dealing with computer-based inventions. Communicating means for communicating by an electric wave is not statutory subject matter according to the four categories of invention defined in 35 U.S.C. 101.
2. Applicant argued Ueda failed to disclose the renewal of information. The renewing of data in Applicant's invention is receiving more information after the information in the buffer of the invention has been played for the user. This is what Ueda did in column 8, lines 62-64. Ueda received additional information to continue playback of the video.
3. Applicant argued Ueda failed to disclose *at least a portion of the plurality of partial information is stored in the means for storing prior to use of the information delivery system by a user*. As clearly shown in figure 12 of Ueda, the terminal memory or *means for storage* contained the picture codes. The invention could not function if the memory did not buffer the video prior to playback.
4. Applicant argued Ueda failed to disclose *at least a portion of the plurality of partial information is stored in the information storage and playback device prior to use of the information delivery system by the user*. Applicant is referred to the above arguments in paragraph 3.
5. Applicant argued the combination of Ueda and Swix failed to disclose *an information provider, who delivers the image, reflection or voice information to the information user by employing the information delivery device, accounts for use of the image, reflection or voice information by the information user, the accounting including cost information attributable to the information user*. Swix was directed to pay-per-view video systems. One of ordinary skill in the art would recognize this as the tracking of cost information attributable to the user, since the user of a pay-per-view system would pay the bill for the usage of such a system.
6. Applicant repeated the arguments addressed in paragraphs 2-5.

Election/Restrictions

7. Claims 33-48 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on 3/8/2006.

Claim Rejections - 35 USC § 101

8. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

9. Claims 11-12 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. In claims 11 and 12, Applicant claims "means for communicating" by an electric wave. Non-statutory subject matter includes means for communicating by an electric wave.

Claim Rejections - 35 USC § 102

10. Claims 1-4, 6, 11-20, and 22 are rejected under 35 U.S.C. 102(e) as being anticipated by Ueda (U.S. Patent No. 5,973,680).

11. In regard to claim 1, Ueda discloses *the information storage and playback device comprises means for storing each of a plurality of partial information of a plurality of delivery information beforehand (column 7, lines 11-12), choosing one of the partial information from the plurality of the stored partial information and reproducing the chosen partial information (column 7, lines 13-21), and means for giving notice of information that the one of the partial information has been chosen from the plurality of the delivery information to the information delivery device just as reproduction of the chosen partial information starts (column 7, line 13); the information delivery device comprises a means for transmitting remaining information of the partial information, which has been chosen to be reproduced and has been notified by the information storage and playback device, to the information storage and playback device just as reproduction of the partial information of the plurality of the delivery information finishes at the information storage and playback device (column 7, lines 16-21); the information storage and playback*

Art Unit: 2145

device includes a means of reproducing the remaining information of the partial information transmitted from the information delivery device, and the partial information of the delivery information, which is transmitted from the information delivery device to the information storage and playback device through the information communicating means and is received and stored in the information storage and playback device, is renewed when necessary (column 8, lines 62-64).

12. In regard to claim 2, Ueda discloses *the information storage and playback device comprises means for storing each of a plurality of partial information of a plurality of delivery information beforehand, means for choosing one of the partial information from the plurality of the stored partial information and reproducing the chosen partial information; and means for giving notice of information that the one of the partial information has been chosen from the plurality of the delivery information to the information delivery device just as reproduction of the chosen partial information starts; the information delivery device includes a means of transmitting remaining information of the partial information which has been chosen to be reproduced at the information storage and playback device to the information storage and playback device while the information storage and playback device is reproducing the partial information; the information storage and playback device includes means of storing the remaining information of the partial information which has been chosen to be reproduced at the information storage and delivery device, and reproducing the stored remaining information of the partial information which has been chosen to be reproduced at the information storage and playback device just as reproduction of the partial information finishes; and at least a portion of the plurality of partial information is stored in the means for storing prior to use of the information delivery system by a user. The limitations of this claim are substantially the same as the limitations of claim 1; therefore the rejection of claim 1 is applicable against claim 2. See also Figure 12 of Ueda for the storage of information in terminal memory.*

13. In regard to claim 3, Ueda is applied as in claim 1. Ueda further discloses *connecting a storage medium, in which the partial information of the delivery information is set up by the information delivery device beforehand, to the information storage and playback device, or transmitting the partial information of the delivery information which is set up by the information delivery device before hand from the information delivery device to the information storage and playback device through the information*

Art Unit: 2145

communicating means and storing the transmitted partial information of the delivery information in a storage medium by the information storage and playback device; transmitting partial information of delivery information, which belongs to an information group chosen to be delivered by the information storage and playback device beforehand, from the information delivery device to the information storage and playback device through the information communicating means, and storing the transmitted partial information of the delivery information which belongs to the information group in a storage medium by the information storage and playback device; transmitting partial information of delivery information, which belongs to one of information groups prioritized and sorted out according to a past record of a user of the information storage and playback device, from the information delivery device of the information storage and playback device through the information communicating means, and storing the transmitted partial information of the delivery information, which belongs to one of the information groups prioritized and sorted out according to the past record of the use of the information storage and playback device, in a storage medium by the information storage and playback device; or transmitting partial information of delivery information, which belongs to one of information groups prioritized and sorted out according to past records of a plurality of users of the information storage and playback devices, from the information delivery device to the information storage and playback device through the information communicating means, and storing the transmitted partial information of the delivery information, which belongs to one of the information groups prioritized and sorted out according to the past records of the plurality of the users of the information storage and playback devices, in a storage medium by the information storage and playback device. Terminal memory is a storage medium. Ueda, column 4, lines 31-41.

14. In regard to claim 4, Ueda is applied as in claim 2. Ueda further discloses *connecting a storage medium, in which the partial information of the delivery information is set up by the information delivery device beforehand, to the information storage and playback device, or transmitting the partial information of the delivery information which is set up by the information delivery device before hand from the information delivery device to the information storage and playback device through the information communicating means and storing the transmitted partial information of the delivery information in a storage medium by the information storage and playback device; transmitting partial information of*

Art Unit: 2145

delivery information, which belongs to an information group chosen to be delivered by the information storage and playback device beforehand, from the information delivery device to the information storage and playback device through the information communicating means, and storing the transmitted partial information of the delivery information which belongs to the information group in a storage medium by the information storage and playback device; transmitting partial information of delivery information, which belongs to one of information groups prioritized and sorted out according to a past record of a user of the information storage and playback device, from the information delivery device of the information storage and playback device through the information communicating means, and storing the transmitted partial information of the delivery information, which belongs to one of the information groups prioritized and sorted out according to the past record of the use of the information storage and playback device, in a storage medium by the information storage and playback device; or transmitting partial information of delivery information, which belongs to one of information groups prioritized and sorted out according to past records of a plurality of users of the information storage and playback devices, from the information delivery device to the information storage and playback device through the information communicating means, and storing the transmitted partial information of the delivery information, which belongs to one of the information groups prioritized and sorted out according to the past records of the plurality of the users of the information storage and playback devices, in a storage medium by the information storage and playback device. Terminal memory is a storage medium. Ueda, column 4, lines 31-41.

15. In regard to claim 6, Ueda is applied as in claim 2. Ueda further discloses *the partial information of the delivery information, which is transmitted from the information delivery device to the information storage and playback device through the information communicating means and is received and stored in the information storage and playback device, is renewed when necessary; and a means for storing the partial information of the delivery information in the information storage and playback device before hand is installed by: connecting a storage medium, in which the partial information of the delivery information is set up by the information delivery device beforehand, to the information storage and playback device, or transmitting the partial information of the delivery information which is set up by the information delivery device beforehand from the information delivery device to the information storage and playback device*

Art Unit: 2145

through the information communicating means, and storing the transmitted partial information of the delivery information in a storage medium by the information storage and playback device; transmitting partial information of delivery information, which belongs to an information group chosen to be delivered by the information storage and playback device beforehand, from the information delivery device to the information storage and playback device through the information communicating means, and storing the transmitted partial information of the delivery information which belongs to the information group in a storage medium by the information storage and playback device; transmitting partial information of delivery information, which belongs to one of information groups prioritized and sorted out according to a past record of a user of the information storage and playback device, from the information delivery device to the information storage and playback device through the information communicating means, and storing the transmitted partial information of the delivery information, which belongs to one of the information groups prioritized and sorted out according to the past record of the user of the information storage and playback device, in a storage medium by the information storage and playback device; or transmitting partial information of delivery information, which belongs to one of information groups prioritized and sorted out according to past records of a plurality of users of the information storage and playback devices, from the information delivery device to the information storage and playback device through the information communicating means, and storing the transmitted partial information of the delivery information, which belongs to one of the information groups prioritized and sorted out according to the past records of the plurality of the users of the information storage and playback devices, in a storage medium by the information storage and playback device. The Examiner interprets this to be transmitting menu information to the user. Ueda teaches this in column 6, lines 35-40 and column 7, lines 22-33.

16. Regarding claims 11-12, Ueda is applied as in claims 1-2. Ueda further discloses *the information communicating means includes at least one selected from a communicating means for communicating by an electric wave, a communicating means for communicating by an electric wave going through a satellite, a communicating means for communicating by a public phone line, and a communicating means for communicating by the Internet. [Ueda discloses a communications line between the terminal and the*

Art Unit: 2145

server. Ueda, column 6, lines 30-32. This communications line broadly encompasses all communicating means discussed within the claim language.]

17. Regarding claims 13-14, Ueda is applied as in claims 1-2. Ueda further discloses use of moving picture information. [Ueda, Abstract]

18. Regarding claims 15-16, Ueda is applied as in claims 1-2. Ueda discloses *the delivery information includes image information, moving picture information, or voice information*. [Ueda, Abstract] Ueda further discloses that in the prior art, motion pictures are commonly transmitted using the MPEG compression coding system, which qualifies as *compressed data information*. [Ueda, column 1, lines 14-25]

19. Regarding claim 17, the limitations of this claim are substantially the same as the limitations in claim 1. Therefore the rationale used in rejecting claim 1 is applied in rejecting claim 17.

20. Regarding claim 18, the limitations of this claim are substantially the same as the limitations in claim 2. Therefore the rationale used in rejecting claim 2 is applied in rejecting claim 18.

21. Regarding claims 19-20, Ueda is applied as in claims 17 and 18. The limitations of claims 19-20 are substantially the same as the limitations in claims 3-4, therefore the rejection applied to claims 3-4 is equally applicable to claims 19-20.

22. Regarding claim 22, Ueda is applied as in claim 18. The limitations of claim 22 is substantially the same as the limitations in claim 6, therefore the rejection applied to claim 6 is equally applicable to claim 22.

Claim Rejections - 35 USC § 103

23. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Art Unit: 2145

24. Claims 7-10 rejected under 35 U.S.C. 103(a) as being unpatentable over Ueda in view of Barton et al. (U.S. Patent No. 6,233,389).

25. In regard to claims 7-10, Ueda is applied as in claims 1 and 2. Ueda fails to disclose utilizing a secondary storage means to store the entirety of information transmitted separately from the preview information stored in the primary storage medium [memory]. However, Barton discloses a system to store an entire video broadcast for later viewing. [Barton, Abstract, column 2, lines 22-33, column 3, lines 62-65, column 4, lines 14-23] Barton discloses use of a hard disk or other storage device. [Barton, column 3, lines 62-63] It would be obvious to one of ordinary skill in the networking art to combine the teachings of Barton and Ueda for storing and displaying video programs. The motivation would be to allow the user to watch a stored program without interruption in case there was a disruption in communication between the server and the client. By this rationale claims 7-10 are rejected.

26. Claims 23-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ueda in view of Swix et al. (U.S. Patent No. 6,609,253).

27. In regard to claims 23-32, Ueda is applied as in claim 1. Ueda discloses a video distribution system. Ueda fails to disclose an accounting system for said video distribution system that keeps track of various versions of time lapsed as described in claims 23-32. Claims 23 and 28 refer only to the accounting system, while claims 24-27 and 29-32 refer to various timekeeping accounting methods. Swix in the same field of endeavor discloses an interactive media system that allows for pay-per-view and video-on-demand service to be sent to a subscriber's personal computer or other viewing device. Swix discloses various time accounting methods in column 7, lines 8-19. More time accounting methods are shown in Swix, column 4, lines 29 – column 5, line 25; Figure 3, column 8, lines 6-15; column 9, line 65 – column 11, line 17. It would be obvious to one of ordinary skill in the art to modify the teachings of Ueda with the teachings of Swix for any type of accounting system to track usage of the video system, so that a user of Ueda could be accurately charged for their use of the Ueda invention. Ueda has given motivation for the combination stating that a typical example of the Ueda system would be a video on demand system (column 1, lines 24-25), which is also described in Swix (Abstract).

Conclusion

28. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.
29. Cordero, Carlos et al. "High Speed Network for Delivery of Education-on-Demand". Proceedings of SPIE the International Society for Optical Engineering. Volume 2667, page 161-172. 1996.
30. Noll, A. Michael. "Internet Pricing Vs. Reality." Communications of the ACM. Volume 40, No. 8. August 1997. ACM Press. 118-121.
31. Ellsworth, Jill H. "Working the Net: Internet Audio Gets Down to Business." NetWorker. Volume 3, Issue 1. March 1999. pp. 21-24.
32. Watson, Richard T. et al. "Integrated Internet Marketing". Communications of the ACM. Volume 43, Issue 6. June 2000. pp. 97-102.
33. Koenen, Rob et al. "Video Portals for the Next Century." Proceedings of the seventh ACM International Conference on Multimedia (Part I). Orlando, FL. 1999. pp. 271-275.
34. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

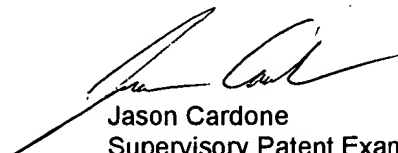
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffrey R. Swearingen whose telephone number is (571) 272-3921. The examiner can normally be reached on M-F 8:30-5:00.

Art Unit: 2145

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jason Cardone can be reached on 571-272-3933. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Jason Cardone
Supervisory Patent Examiner
Art Unit 2145